

REMARKS/ARGUMENTS

Claims 1-21 are pending in the present application. Claims 1, 5, 13, 15 and 19 have been amended herewith. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 112, Second Paragraph

Claims 1-8 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. This rejection is respectfully traversed.

With respect to Claim 1, the Examiner notes confusion as to what is responsive to 'receiving'. Applicants respond by showing that the 'displaying' step is responsive to the 'receiving' step. Applicants have amended Claim 1 to restate what is already believed to be the plain, normal meaning of Claim 1.

Therefore, the rejection of Claim 1 (and dependent Claims 2-8) under 35 U.S.C. § 112, second paragraph has been overcome.

II. 35 U.S.C. § 101

Claims 1-20 stand rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. In rejecting Claims 1-20, the Examiner states that these Claims 1-20 "claims a data structure, however it appears the limitations of said claim are merely claiming statements defining various items, therefore said limitations do not appear to be defining any functional interrelationships which permits the computer program's functionality (or data structure's functionality) to be realized". This rejection is respectfully traversed.

Claim 1 is directed to *a method in a data processing system* for managing display of a new document, and is not directed to a mere data structure as alleged by the Examiner. For example, Claim 1 recites:

"A method in a data processing system for managing display of a new document, the method comprising:

displaying, in response to receiving a user input indicating that the new document is to be displayed, a list of browser windows including an indication of a presently displayed document in each respective browser window in the list of browser windows;
and

responsive to a user selection of a browser window from the list of browser windows, replacing a document displayed in the browser window with the new document.”

Methods are processes¹, and processes are explicitly enumerated in 35 U.S.C. § 101 to be statutory². Thus, the Examiner’s rejection of Claim 1 (and dependent Claims 2-8) under 35 USC 101 is clearly erroneous.

With respect to Claim 9, such claim explicitly recites *a data processing system*, which is a machine. Machines are explicitly enumerated in 35 U.S.C. § 101 to be statutory³. Thus, the Examiner’s rejection of Claim 9 (and dependent Claims 10-14) under 35 USC 101 is clearly erroneous.

With respect to Claim 15, such claim recites that the computer program product is encoded in a computer readable medium and operable in a data processing system for managing caching of data by a browser, as specifically allowed for per the requirements of MPEP 706.03(a) and 2106. See, in particular, MPEP 2106(IV)(B)(1)(a) where it states:

“A claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.”

Accordingly, as Claim 15 expressly recites a computer program product encoded in a computer readable medium and operable in a data processing system for managing display of a new document, it is shown that Claim 15 (and similarly for dependent Claims 16-20) is directed to statutory subject matter, pursuant to both judicial case law and the USPTO’s own MPEP rules.

¹ 35 U.S.C. 100 Definitions

(b) The term “process” means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material (emphasis added by Applicants).

² 35 U.S.C. 101 Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title (emphasis added by Applicants).

³ 35 U.S.C. 101 Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title (emphasis added by Applicants).

Still further, Claim 15 explicitly recites a computer program product encoded in a computer readable medium and operable in a data processing system for managing display of a new document, which is either a 'manufacture' or a 'composition of matter', both of which are statutorily recognized subject matter. In addition, since Claim 15 explicitly recites a computer program product encoded in a computer readable medium and operable in a data processing system, such claim does *not* fall within one of the three judicially determined exceptions of: natural phenomenon, law of nature or abstract idea (see, e.g., MPEP 2106 and in particular MPEP 2106(IV)(B) and (C)), but instead is limited to a practical application in the technological arts⁴. Thus, it is further shown that Claim 15 has been erroneously rejected under 35 U.S.C. § 101 as the invention recited therein does not fall within a judicial exception but instead is limited to a practical application in the technological arts.

Therefore, the rejection of Claims 1-20 under 35 U.S.C. § 101 has been overcome.

III. 35 U.S.C. § 102, Anticipation

Claims 1-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Saylor et al. (US Patent Application Publication 2002/0186238). This rejection is respectfully traversed.

For a prior art reference to anticipate in terms of 35 U.S.C. 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Applicants will now show that every element recited in Claims 1-21 is not identically shown in the cited Saylor reference, and thus Claims 1-21 have been erroneously rejected under 35 U.S.C. § 102(e).

Claim 1 recites a step of "displaying, in response to receiving a user input indicating that the new document is to be displayed, a list of browser windows including an indication of a presently displayed document in each respective browser window in the list of browser windows". As can be seen, there is a 'displaying' step, and this displaying step occurs in response to a step of receiving a user input indicating that a *new document is to be displayed*. Further, Claim 1 states that *what* is displayed is (1) a list of browser windows and (2) an indication of a presently displayed document in each respective browser window in the list of browser windows. This can be seen in Applicants' preferred embodiment depicted in Figure 4B, element 426, where both (1) a list of browser windows is displayed, *as well as* (2) an indication of a presently displayed document in each respective browser window in the list of browser windows. This is substantially different from the teachings of the cited reference. The Examiner states that the display of these two categories of items is described by Saylor at paragraphs 0152 and 0177, and in

⁴ *Only when* the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. § 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971).

particular noting the 'title bar' feature. Applicants urge error in such assertion. As Saylor describes at paragraphs 0152:

"[0152] The "File" dropdown menu 518 includes dropdown items 519 for "New", "Open", "Delete", "Connect to server", "New window", "Recent list", and "Exit". "New" allows user 23 to select logical hierarchy 30 to open in a new display window 50, while "Open" allows the same selection but uses an existing display window 50. "Delete" allows the user to close such display window 50. "Connect to server" opens a login dialog (not shown) so that user 23 may present credentials to web server 60. "New window" opens a redundant version of the current display window 50. "Recent list" is a flexible list of several dropdown items 519, each dropdown item 519 corresponding to a recently used logical hierarchy 30. Menu separators 521 can bracket the "Recent list". "Exit" starts a process to close client application 22."

As can be seen, this paragraph describes various actions that are selectable from a File dropdown menu, including (1) New, (2) Open, (3) Delete, (4) Connect to Server, (5) New window, (6) Recent list and (7) Exit. Because Claim 1 recites that the displaying step occurs in response to a user indicating that a 'new' document is to be displayed, the relevant portion of the above cited passage would be the discussion pertaining to (1) New or (2) Open or (5) New window. This cited passage states that in response to a user indicating that a 'new' document is to be displayed, *the user 23 is allowed to select logical hierarchy 30 to open in a new or existing display window 50*. Selecting logical hierarchy 30 to open a new or existing display window 50 does not teach any displaying of both (1) a list of browser windows, *as well as* (2) an indication of a presently displayed document in each respective browser window in the list of browser windows. Instead, and as can be seen by Saylor's Figure 6B, a display window 50 is displayed. There is nothing shown/displayed in this display window 50 that indicates either (1) a list of browser windows is displayed, or (2) an indication of a presently displayed document in each respective browser window in the list of browser windows, both of which are explicitly recited in Claim 1. Instead, menus of *commands* are depicted. Thus, this cited passage does not teach the displaying step recited in Claim 1.

Nor does the Saylor cited passage at paragraph [0177] overcome this 'displaying' step teaching deficiency. There, Saylor states:

"[0177] Main UI class 67 presents display window 50 that is the first interactive window presented by client application 22 at startup. When user 23 chooses dropdown item 519

(shown in FIG. 6B) such "New" or "Open" that opens logical hierarchy 30 for display, an instance of Main UI class 67 manages the displaying. As shown in FIG. 7B, Main UI class 67 launches objects including synch browser manager 68, viewer model 69, and viewer 64."

This passage states that in response to a user choosing a 'New' or 'Open' command, a logical hierarchy 30 is open for display, and a synch browser manager, viewer model and viewer are launched. The 'opening of a logical hierarchy for display' does not teach the claimed step of displaying (1) a list of browser windows and (2) an indication of a presently displayed document in each respective browser window in the list of browser windows, as expressly recited in Claim 1. Instead, such opening of a logical hierarchy is described as being a flexible structure for collecting resource profiles and their relevant dependency relationships under one or more conceptual frameworks (Sylor paragraph [0084]). Thus, as every element recited in Claim 1 is not identically shown in a single reference - and in particular there is no teaching of displaying, in response to receiving a user input indicating that the new document is to be displayed, a list of browser windows including an indication of a presently displayed document in each respective browser window in the list of browser windows - it is urged that Claim 1 is not anticipated by the cited reference.

Applicants initially traverse the rejection of Claims 2-8 for reasons given above with respect to Claim 1 (of which Claims 2-8 depend upon).

Further with respect to Claim 4, such claim recites "wherein the indication is a thumbnail of the document" (with the 'indication' being defined per Claim 1 to be 'an indication of a presently displayed document in each respective browser window in the list of browser windows'). In rejecting Claim 4, the Examiner states that this claimed feature is taught by Sylor at paragraph [0102]. Applicants urge that there, Sylor states:

"[0102] Title bar 511 contains text identifying client application 22 as the owner of display window 50 among the (possibly several) applications running on operating system 631 (shown in FIG. 1B). Title bar 511 provides other functions specific to operating system 631. Usually the functions include the ability to relocate, resize, request the close of, or restore the size of, display window 50."

As can be seen, this cited passage describes (1) text that identifies the client application that is the owner of the display (as there can be multiple applications running), and (2) an ability to manipulate the window by moving, sizing or closing the window. This is different from what is recited in Claim 4 for at least two

reasons. First, this cited passage does not describe *any* type of indication of a presently displayed document in each respective browser window in the list of browser windows. Secondly, this cited passage does not describe any *thumbnail* of a document, as expressly recited in Claim 4. Thus, Claim 4 has been erroneously rejected as there are at least two claimed features (as described above) that are not taught by either this cited passage or the cited reference as a whole.

Further with respect to Claim 5, such claim recites “wherein the list of browser windows is displayed in a pop-up menu”. As can be seen, the list of browser windows (i.e. a list of multiple browser windows) is displayed in a pop-up menu per the features of Claim 5. In rejecting Claim 5, the Examiner states that this claimed pop-up window that displays a list of browser windows is taught by Sylor at paragraphs [0152] and [0177]. Appellants respectfully submit that the Sylor description at paragraph [0152] describes a *menu with commands* that can be selected for execution by a user. There is no list of browser windows in file menu 518 (see, e.g., Sylor Figure 6B). As to the Sylor description at paragraph [0177], this passage describes this same file menu 518, and this cited passage also does not describe any type of list of browser windows. Thus, it is further urged that Claim 5 has been erroneously rejected as there are additional claimed features that are not identically shown in the cited Sylor reference.

Applicants initially traverse the rejection of Claims 9-21 for similar reasons to those given above with respect to Claim 1.

Applicants further traverse the rejection of Claims 12 and 18 for similar reasons to the further reasons given above with respect to Claim 4.

Applicants further traverse the rejection of Claims 13 and 19 for similar reasons to the further reasons given above with respect to Claim 5.

Therefore, the rejection of Claims 1-21 under 35 U.S.C. § 102(e) has been overcome.

IV. Conclusion

It is respectfully urged that the subject application is patentable over the cited reference and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: April 30, 2007

Respectfully submitted,

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